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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/801,207	03/16/2004	Bey-Dih Chang	99,216-VV	3124

7590

04/04/2006

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EXAMINER

MARVICH, MARIA

ART UNIT PAPER NUMBER

1633

DATE MAILED: 04/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/801,207

Applicant(s)

CHANG ET AL.

Examiner

Maria B. Marvich, PhD

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### **DETAILED ACTION**

Claims 1-25 are pending in this application and subject to restriction.

#### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-3, 6, 7 and 8, drawn to a method of inhibiting senescence by induction of a gene by p21 expression, classified in class 435, subclass 6.
- II. Claims 1, 4, 5, 6, 7 and 8, drawn to a method of inhibiting senescence by repression of a gene by p21 expression, classified in class 435, subclass 6.
- III. Claims 9-11, 14-16, 17-19 and 22-25, drawn to a method of promoting or inducing senescence by induction of a gene by p21 expression, classified in class 435, subclass 6.
- IV. Claims 9, 12, 13, 14-16, 17, 20, 21 and 22-25, drawn to a method of promoting or inducing senescence by repression of a gene by p21 expression, classified in class 435, subclass 6.

The inventions are distinct each from the other because of the following reasons:

Inventions I-IV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). The instant specification does not disclose that these methods would be used together. The method of method of inhibiting

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senescence by induction of a gene by p21 expression, the method of inhibiting senescence by repression of a gene by p21 expression, the method of inducing senescence by induction of a gene by p21 expression and the method of inducing senescence by repression of a gene by p21 expression are unrelated as they comprise distinct steps and utilize different products, which demonstrates that each method has a different mode of operation. Each invention performs this function using a structurally and functionally divergent material. Compounds that repress or induce gene expression are distinct structurally and perform their functions by distinct methods resulting in distinct outcomes that have structurally and functionally distinct outcomes. Therefore, each method is divergent in materials and steps. For these reasons the Inventions I - IV are patentably distinct.

Because these inventions are distinct for the reasons given above, and the search required for each group is not required for the other groups because each group requires a different non-patent literature search due to each group comprising different products and/or method steps, restriction for examination purposes as indicated is proper. Specifically, a search for inhibition and promotion of senescence by induction versus repression require distinct searches for genes induced or repressed. As well, a search for methods of inhibition is distinct from searches for induction or promotion. Therefore, a search for all methods constitutes a search burden.

This application contains claims directed to the following patentably distinct species:

- 1) species of genes recited in claim 3, 11 and 19.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 2, 10 and 18 are generic.

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2) species of genes recited in claims 5, 13 and 21.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 4, 12 and 20 are generic.

3) species of methods of detection by immunological reagents, assaying for cellular gene products and hybridization.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 9 and 17 are generic.

The species are independent or distinct because the inventions as claimed do not overlap in scope, i.e., are mutually exclusive; the inventions as claimed are not obvious variants; and the inventions as claimed are either not capable of use together or can have a materially different design, mode of operation, function, or effect.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

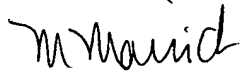
Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maria B. Marvich, PhD whose telephone number is (571)-272-0774. The examiner can normally be reached on M-F (6:30-3:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Nguyen, PhD can be reached on (571)-272-0731. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Maria B Marvich, PhD  
Examiner  
Art Unit 1633

March 31, 2006